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Attorney Docket No. 63049.000088
Attorney Customer No. 27682

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of:

Ronald D. BLUM et al.

Serial No.: 10/644,112

Filing Date: August 20, 2003

Group Art Unit: 2873

Examiner: Jordan M. Schwartz

Confirmation No: 6506

Title: METHOD OF MANUFACTURING AN ELECTRO-ACTIVE LENS

MAIL STOP AMENDMENT

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT
UNDER 35 U.S.C. § 121

Sir:

The present communication is responsive to an Office Action dated September 24, 2004 in the above-captioned application (the "Application") requiring a restriction of the claims submitted for examination.

Claims 1-32 are currently pending in the Application. In the Office Action, it was asserted that the Application contains claims which are directed to two distinct inventions.

As a result, the Examiner issued a Restriction Requirement requiring the election of a single group of claims for prosecution. The claims, as grouped by the Examiner, appear as follows:

- Group I: Claims 1-31, drawn to a method of making an electro-active lens, classified in class 351, subclass 177.
- Group II: Claim 32, drawn to an electro-active lens, classified in class 351, subclass 159.

In the event that Applicants elect the claims of Group I, the Examiner has required the Applicants to select a single disclosed species for examination. The Examiner has asserted that Group I contains claims directed to two patentably distinct species: Group Ia, claims 1-30, directed to a species of method of making an electro-active lens having a covering layer formed over a lens blank containing an electro-active element and Group Ib, claim 31, directed to a species of method of making an electro-active lens having a lens blank formed around an electro-active element and a conductive bus.

Applicants respectfully traverse the restriction requirement.

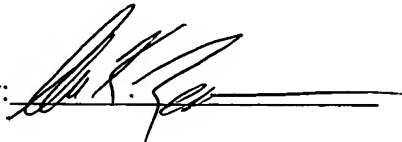
Applicants submit that the claims of the designated groups have not necessarily acquired a separate status in the art for examination purposes, notwithstanding possible different art classifications which may have been artificially assigned thereto in the Patent Office. Art very relevant to the patentability of one group might logically be found in the art classes assigned to one of all of the other claim groups. The classification cited in support of the election requirement is merely used for cataloging purposes and is not conclusive of the propriety of such a requirement.

Furthermore, under the patent statute, 35 U.S.C. § 121, an application may be properly required to be restricted to one of two or more claimed inventions, only if they are able to support separate patents and they are either independent or distinct. 37 C.F.R. § 1.141; MPEP 803. However, if the search and examination of an entire application can be made without serious burden, then the examiner must examine it on the merits, even if it includes claims to distinct or independent inventions. MPEP 803. Applicants respectfully submit that given the overlapping subject matter of the claims of Group I, claim 31 could be examined together with claims 1-30 with little additional burden on the Examiner.

Notwithstanding the above, in order to comply with the Restriction Requirement, Applicants elect with traverse, the claims of Group I for further prosecution and further elect to prosecute the species identified by the Examiner as Group Ia, claims 1-30. Applicants request that the remaining claims be held in abeyance under provisions of 37 C.F.R. § 1.142(b) until final disposition of the elected claims.

Date: October 13, 2004

Respectfully submitted,

By: 

Shawn K. Leppo
Registration No. 50,311

Please direct all correspondence to:

J. Michael Martinez de Andino
HUNTON & WILLIAMS, LLP
Riverfront Plaza, East Tower
951 East Byrd Street
Richmond, VA 23219-4074
(804) 788-7216 telephone number
(804) 343-4549 facsimile number



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CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8

MAILSTOP AMENDMENT
Commissioner for Patents
PO Box 1450
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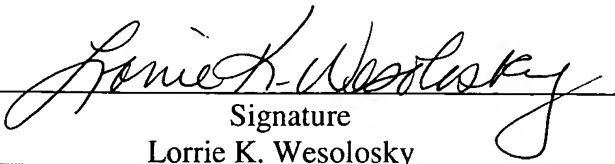
Sir:

I hereby certify that this correspondence is being deposited with the United States Postal

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PO Box 1450
Alexandria, VA 22313-1450

on October 13, 2004
Date


Signature

Lorrie K. Wesolosky

Typed or printed name of person signing Certificate

Documents being submitted with this Certificate of Mailing include:

- 1) Response Transmittal Letter
- 2) Response to Restriction Requirement in connection with the Office Action
dated September 24, 2004
- 3) Self addressed stamped return postcard

HUNTON & WILLIAMS, LLP
Riverfront Plaza, East Tower
951 East Byrd Street
Richmond, VA 23219
(804) 788-8200 (Telephone)
(804) 788-8218 (Facsimile)



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RESPONSE TRANSMITTAL LETTER

MAIL STOP AMENDMENT

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

Enclosed is a Response to Restriction Requirement Under 35 U.S.C. § 121 in connection with the Office Action dated September 24, 2004 for the above-identified patent application.

- ☐ A petition for Extension of Time is also enclosed.
- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) is also enclosed.
- ☒ No additional claim fee is required.
- ☐ Charge \$_____ to Deposit Account No. 08-3436 for the fee due.
- ☐ Check No. _____ in the amount of \$_____ is enclosed for the fee due.
- ☒ Self-addressed stamped postcard.


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Page 2 of 2

[X] The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §1.16, 1.17 and 1.21 that may be required by this paper to Deposit Account No. 08-3436.

Date: October 13, 2004

Respectfully submitted,

By:


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Registration No. 50,311

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